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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,244	04/09/2001	Guy H. Smith III		5002
7590	10/04/2006			
Guy H. Smith 630 Taylor Ave Alameda, CA 94501			EXAMINER KESACK, DANIEL	
			ART UNIT 3624	PAPER NUMBER

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/828,244	Applicant(s) SMITH, GUY H.	
	Examiner Dan Kesack	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 1-5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amendment filed July 14, 2006 has been entered and fully considered.

Amended claims 1-5 are currently pending. The rejections are as stated below.

Drawings

2. The drawings were received on July 14, 2006. These drawings are accepted.

Specification

3. The amendment filed July 14, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the original disclosure did not contain information pertinent to eliminating redundant reporting, or subscribers terminating donations. As such, the amendments to the specification in response to item 7, listed in the amendment filed July 14, 2006, constitute new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

4. Examiner is under the assumption that, in resubmitting the amended claims to comply with standards, Applicant has inadvertently misnumbered the claim dependencies. Referring to the originally filed "Enclosure #2" dated May 24, 2006, Examiner has interpreted claim 2 as being intended to recite "A method as in claim 1..." and claim 3 as being intended to recite "A method as in claim 3..." For the purposes of Examination, and for application of prior art, Examiner will interpret the claims in this way. Appropriate corrections correctly reciting Applicant's intended dependencies are required.

Examiner respectfully notes that the non-compliance notice dated July 6, 2006 in response to the claim listing filed by Applicant on May 24, 2006, was filed because Applicant did not indicate the status of claims 1-4 originally filed April 9, 2001. If Applicant intended the revised claims to constitute a new claim listing, Applicant could have complied by indicating "Claims 1-4 are cancelled", followed by Applicant's new claims. As submitted on July 14, 2006, Applicant has presented the new claim 3 as an amended form of claim 3 filed April 9, 2001, which Examiner believes was not intended. Applicant indicates claim 4 has no changes, however claim 4 as presented on July 14, 2006 is substantially changed from claim 4 previously presented on April 9, 2001. See MPEP 714(II)C for further discussion of amendments to claims.

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5. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). Because claim 3 is a new claim, it must be numbered as such, a new claim amounting to claim 6.

Misnumbered claim 3 has been renumbered 6.

Misnumbered claim 4 has been renumbered 3.

Misnumbered claim 5 has been renumbered 4.

6. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form. Claim 1 is directed towards a method for facilitating donations from donors to organizations, whereas claim 2, which depends from claim 1, is directed towards a method for communicating requests for action from donors, and does not further limit claim 1, because the methods have different utilities. Likewise, claim 3 does not further limit claim 2, for the same reasons stated above.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Specifically, claim 3 is recited to depend from claim 6, however there is no claim 6 in the listing of claims. Examiner is unable to determine from which claim Applicant has intended claim 3 to depend.

Claim Rejections - 35 USC § 102

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 1, 3, and 4 remain rejected under 35 U.S.C. 102(b) as being anticipated by Burke, U.S. Patent No. 5,621,640.

Claim Rejections - 35 USC § 103

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. Claim 2 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Burke, as applied to claim 1 above, and further in view of Mull, U.S. Patent No. 6,898,575.

Response to Arguments

14. Applicant's arguments filed July 14, 2006 have been fully considered but they are not persuasive.

15. In response to item 10, Examiner respectfully notes that although the terms "subscriber" and "donor" may be used interchangeably in the present invention, all terminology must be consistent throughout claims to ensure clearly defined limits of patentability desired. Regardless, Examiner respectfully thanks the Applicant for clarifying the language of claim 4.

16. In response to Applicant's arguments of the rejection under U.S.C. 102(b) of claims 1, 2 and 4, and the rejection under U.S.C. 103(a) of claim 3, Examiner respectfully disagrees.

While Examiner acknowledges some of the features of the embodiments listed in Applicant's specification may or may not be explicitly disclosed in the prior art, this is irrelevant to the patentability of the invention *as claimed*. In the arguments submitted on July 14, 2006, Applicant's arguments amount to features and elements not present in the claim language. A requirement for patentability is that the Applicant's claims distinguish over the prior art. Examiner also respectfully notes that claim language is given its broadest reasonable interpretation, in light of the specification, but without reading any limitations from the specification into the claims. As such, while it appears Applicant believes the claim language is specific enough to clearly define Applicant's invention, broad, yet reasonable interpretations of the claim language reads on the prior art disclosed. For example, on page 5 of Applicant's arguments, Applicant states "Mull does not teach a communication of requests from donor to donee." Examiner respectfully disagrees because Mull teaches "donors may express preferences as to how the donated funds are used," which Examiner has reasonably interpreted as teaching "a communication of requests from donor to donee." Similarly, Examiner maintains that Mull teaches "eliminating redundant reporting" because Mull establishes a report for each donation, and Examiner argues that reports which detail different donations made at different times are not "redundant".

As detailed in the previous Office Action, Examiner maintains that the method steps and elements of the Applicant's claims, as currently presented, are taught in the prior art.

17. In response to Applicant's argument that the reference Mull is not applicable as prior art, Examiner respectfully points out that the Mull application was granted priority to a provisional application filed May 10, 2000. As such, the Mull patent is given the benefit of a May 10, 2000 filing date as a prior art reference.

However, it appears Applicant has asserted that the claimed invention was conceived on January 21, 2000, before the priority date of Mull, and was reduced to practice after said priority date, on February 11, 2001. Examiner notes that the submitted evidence may or may not be sufficient to establish prior invention. Evidence of prior invention must be submitted pursuant to 37 CFR 1.131, which, among other things, requires the Applicant to submit an affidavit supporting such evidence. A portion of 37 CFR 1.131 has been reproduced below:

The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

Upon cursory examination of Applicant's submitted "Lab Book," Examiner further advises Applicant to review the requirements of "Reasonable Diligence" disclosed in MPEP 2138.06.

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18. In response to applicant's argument that Miller and Burke teach away from each other, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In the present case, the teachings of Mull may be incorporated into the invention, as disclosed by Burke, and it would be obvious to do so because they are both concerned with philanthropic donations, and for the reasons cited in the prior Office Action. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

19. Newly presented claim 6 presents new matter not disclosed and sufficiently enabled by Applicant's original specification, and therefore it has not been considered in light of the prior art. Specifically, Applicant's disclosure does not enable one of ordinary skill in the art to report single requests from donors to be removed from organization fund raising campaigns.

Conclusion

20. This action is a **final rejection** and is intended to close the prosecution of this application. Applicant's reply under 37 CFR 1.113 to this action is limited either to an appeal to the Board of Patent Appeals and Interferences or to an amendment complying with the requirements set forth below.

If applicant should desire to appeal any rejection made by the examiner, a Notice of Appeal must be filed within the period for reply identifying the rejected claim or claims appealed.

If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier.

A reply under 37 CFR 1.113 to a final rejection must include the appeal from, or cancellation of, each rejected claim. The filing of an amendment after final rejection, whether or not it is entered, does not stop the running of the statutory period for reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply, or any extension of this period obtained under either 37 CFR 1.136(a) or (b), the application will become abandoned.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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